

Application Number 10/644,494

Amendment responsive to Office Action mailed July 25, 2005

### **REMARKS**

This Amendment is responsive to the Office Action dated July 25, 2005. Applicant has amended claims 1, 7, 15, 23 and 25; canceled claims 2-6, 14, 16-18, 21-22, 24, and 26; and added new claim 27. Claims 1, 7-13, 15, 19-20, 23, 25, and 27 are now pending.

### **Restriction under 35 U.S.C. § 121**

In the Office Action, the Examiner restricted claims 1-26 under 35 U.S.C. § 121 as follows:

Group I. Claims 1-20, and 23-26; and

Group II. Claims 21-22.

During a telephonic conversation with the Examiner on July 6, 2005, Applicant provisionally elected Group I with traverse. Applicant hereby affirms this election without traverse. Please cancel non-elected claims 21 and 22 at this time. Applicant reserves the right to present claims 21 and 22 in a divisional application.

### **Claim Rejections Under 35 U.S.C. § 102 and 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 1, 4, 5, 8, 9, 16, 19, 20, 23 and 26 under 35 U.S.C. §102(b) as being anticipated by Lee (US 5,748,912) and rejected claims 2, 3, 24, 6, 7, 10-15, 17, 18 and 26 under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Jones et al. (US 6,438,638).

Applicant has made several amendments to the independent claims in order to clarify the invention. Applicant respectfully traverses the rejections to the extent such rejections may be considered applicable to the amended claims.

All of Applicant's pending claims recite a memory card that includes two different connectors. In particular, all pending claims require the memory card to include a first connector that conforms to a first connector standard and a second connector that conforms to a second connector standard. Claims 1 and 15 are independent claims directed to memory cards. Claims 23 and 27 are independent claims directed to systems that include a memory card and the first and second devices to which the memory card can be attached via the first and second

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connectors. The memory card recited in claim 1 is similar to that recited in system claim 23, while the memory card recited in claim 15 is similar to that recited in new system claim 27.

In this Amendment, all pending claims have been amended to clarify that the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard, e.g., as formerly recited in dependent claim 6.

In addition, claims 1 and 23 have been amended to clarify that memory card includes a controller that controls the memory and controls output via the first connector and the second connector, wherein the first and second connectors are electrically coupled to the memory through the controller and wherein the controller comprises a memory controller integrated with a first connector controller conforming to the first connector standard and integrated with a second connector controller conforming to the second connector standard. These features were formerly recited in claims 17 and 18.

In contrast to claims 1 and 23, claims 15 and 27 now require that the memory card include two controllers, i.e., first and second controllers. The first controller is electrically coupled to the memory and the first connector, and controls both the memory and output via the first connector, wherein the first controller comprises a memory controller integrated with a first connector controller conforming to the first connector standard. The second controller is electrically coupled to the second connector and the first controller, the second controller controlling output via the second connector and conforming to the second connector standard, wherein the first connector is electrically coupled to the memory through the first controller, and the second connector is electrically coupled to the memory through the second controller and the first controller.

Since all pending claims now include the limitations formerly recited in claim 6, the rejections under 35 U.S.C. §102(b) have been overcome.

Applicant respectfully traverses the former rejection to claim 6 to the extent the Examiner may consider it applicable to the amended claims. A person of ordinary skill in the art would not have been motivated to modify the device of Lee with the teaching of Jones, as suggested by the Examiner. On the contrary, a person of ordinary skill in the art would have consciously avoided

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such modifications because these modifications would have undermined the functional purpose of the device of Lee.

In the former rejection of claim 6, the Examiner recognized that Lee fails to disclose or suggest a memory card that includes a first connector that conforms to a HCC standard and a second connector that conforms to a DCC standard. However, the Examiner cited Jones as suggesting a DCC standard connector and concluded that a person of ordinary skill in the art would have been motivated to modify the device of Lee in view of the teaching of Jones to arrive at the features recited in claim 6 (which are now included in all pending independent claims).

Unfortunately, the Examiner's analysis is fundamentally flawed insofar as the modification to Lee, proposed by the Examiner, would have clearly undermined the functionality of the Lee device, as explained below. For this reason, a person of ordinary skill in the art would have consciously avoided the modifications proposed by the Examiner.

Lee describes a removable CPU card. In this sense, Lee is actually in a different field than Applicant's invention. Since Applicant's claims do not preclude the existence of a processor, however, Applicant will focus the following discussion on other differentiating aspects of the claims relative to Lee and Jones. FIG. 4A of Lee is copied below.

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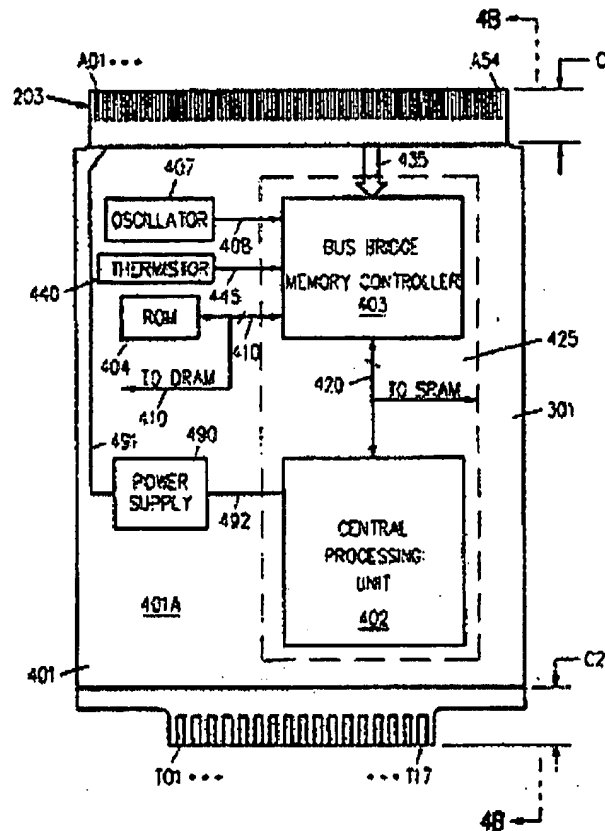


FIG. 4A

In the Office Action, the Examiner interpreted FIG. 4A of Lee as disclosing a first connector (A01-A54) that conforms to a first connector standard and a second connector (T01-T17) that conforms to a second connector standard. As a preliminary observation, this interpretation is erroneous insofar as FIG. 4A does not show first and second connectors that conform to first and second connector standards. Specifically, elements T01-T17 do not define a connector that conforms to a connector standard. Instead elements T01-T17 are "test contacts used for testing of the CPU card." See column 8, lines 57-60. Nothing in Lee suggests that test contacts T01-T17 conform to any type of connector standard.

Notwithstanding this distinction, Applicant has nevertheless amended all pending claims to clarify that the first connector standard that the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard, e.g., as formerly recited in dependent claim 6.

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In the rejection of claim 6, the Examiner indicated that Jones describes the use of a connector that complies with a DCC standard. The Examiner concluded that a person of ordinary skill in the art would have been motivated to include a connector that complies with a DCC standard, as described by Jones, in the device of Lee.

This conclusion is fundamentally flawed, however, insofar as the inclusion of a connector that complies with a DCC standard in the device of Lee would have undermined the ability to use the connector for testing of the CPU card of Lee. In other words, if elements T01-T17 were replaced with a DCC standard connector, the ability to test the CPU card, as taught by Lee, would be compromised. For this reason, a person of ordinary skill in the art would have clearly avoided the combination proposed by the Examiner in the rejection of claim 6.

Furthermore, it is entirely unclear what advantage a DCC standard connector in the device of Lee would provide. For example, there would not have been any desire to connect the Lee card to a device having a DCC standard connector because the Lee card is a CPU card that would not be used with a device via a DCC standard connector. Furthermore, it seems that the entire layout of the Lee device would need to be overhauled to provide DCC operation. A person of ordinary skill in the art would not have even considered such modifications desirable.

To even further distinguish the references of record, Applicant has amended claims 1 and 23 to require a single integrated controller that controls both of the first and second connectors and the memory. The applied references lack any teaching of a memory card architecture having a single controller to control both of the first and second connectors and the memory.

In contrast to claims 1 and 23, claims 15 and 27 now require two different controllers. In these claims, a first controller is electrically coupled to the memory and the first connector, and controls both the memory and output via the first connector, wherein the first controller comprises a memory controller integrated with a first connector controller conforming to the first connector standard. The second controller is electrically coupled to the second connector and the first controller, the second connector controller controlling output via the second connector and conforming to the second connector standard, wherein the first connector is electrically coupled to the memory through the first controller, and the second connector is electrically coupled to the memory through the second controller and the first controller. The applied references also lack any teaching of this memory card architecture that includes two controllers.

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In view of the claim amendments and foregoing comments, Applicant respectfully submits that all claims in this application are in condition for allowance. Applicant requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

10/3/5

Imation Legal Affairs  
P.O. Box 64898  
St. Paul, Minnesota 55164-0898  
Telephone: (651) 704-3604  
Facsimile: (651) 704-5951

By:



Name: Eric D. Levinson  
Reg. No.: 35,814